

REMARKS

The following is in response to the Notice of Non-Compliant Amendment ("Notice") in the above-referenced Application mailed February 22, 2010.

In the Amendment of April 4, 2009, the Examiner indicated that claims indicated as reading on the elected species at the time of the requirement were: 1, 2, 7 – 12, 14, 15, 18, 19 and 22-28.

Claims 1 and 8 are currently amended to incorporate the limitations of claim 12 and 22. Claims 12 and 22 are canceled.

Claim 21 is amended to depend from claim 1.

The "Status of Claims" of May 28, 2009 is updated, by virtue of incorporation of limitations of claims 12 and 22 into claims 1 and 8, to the extent that it is respectfully submitted that the current status of claims is as follows:

Claims 1-4, 7 – 11, 13-17, 18, 19-21 and 23-28, all depending from species claims and reading on the elected species, are currently under examination;

Claims 5-6, reading on non-elected species, are withdrawn but will be considered following determination of allowability of claim 1; and

Claims 12, 22 and 29-37 are canceled.

That is, by incorporation of claims 12 and 22, it is submitted that claims 1 and 8 and all claims depending therefrom are within the elected species. Indication of allowability of the elected species, and thereafter consideration of claims 5 and 6 and any other claims deemed by the Examiner to be outside of scope of the presently elected species, is respectfully requested.

Should the Examiner require change in designation of any claim, Applicant will do so if required.

Briefly reviewing, in response to a Restriction Requirement between the invention of Group I (drawn to transport pipe and method of use) and Group II (method of making a pipe), on March 3, 2009, Applicants elected Group I.

In response to an election of species requirement, Applicants elected Fig. 1 wherein the inventive joint shows a wave contour joint (as compared to Fig. 4 and 5 showing no wave contour).

Claims indicated by Applicant as reading on the elected species of Fig. 1 included claims 1, 12 (ring sleeve exhibits a wave shape) and 22 ("sequential wave peaks exhibit decreasing radial height").

As indicated by the Examiner, Applicant has received examination of claims 1, 12 and 22, thus claims limited to the subject matter of claims 1 plus 12 plus 22 can not be withdrawn as not corresponding to the elected species.

All current claims under examination, including base claims 1 and 8, include the limitation of original claims 12 and 22.

Thus, according to the Examiner's own standards set forth in the Notice of Non-Compliant Amendment, the current Amendment is limited to subject matter previously designated as corresponding to the invention of Fig. 1, and previously examined, thus can not be withdrawn as belonging to non-elected species.

Regarding the Notice, Applicants provide the following response.

In the present patent application, the figures show only two embodiments, Figures 1, 2 and 3 illustrating the first "wave" embodiment of the joint of the invention. Figure 3 is merely an enlarged view. As indicated in paragraph [0043] of the specification as published: "*In the exemplary embodiment shown in Figs. 1, 2 and 3 ...* The description of Fig. 2 states that it illustrates *"the same joint element"*, and the description of Fig. 3 indicates that it is an enlarged view of *the joint element*.

Thus, by electing Fig. 1, Applicants elected the wave joint embodiment shown identically in Figs. 1-3.

The Examiner's indication that Fig. 2 and 3 were not elected, and his position that subject matter shown in Fig. 2 and 3 should be withdrawn, does not make sense technically or legally, as it is not possible to withdraw the subject matter of Figs. 2 and 3 without also withdrawing the subject matter of Fig. 1.

The Examiner is requested to explain what joint element feature is shown in Fig. 1 that is not also shown in Fig. 2 and 3. Absent the Examiner's explanation of difference of species, it follows that there is only one species, as indicated repeatedly in the present specification.

Applicants point out that the joint shown on the right side of Fig. 1 is not an inventive pipe joint. The inventive pipe joint is shown on the left side of Fig. 1.

The Examiner in the Notice at page 2 indicates that “applicant provided a list of claims which read on the elected Fig. 1, and claims 20 and 21 were deemed by applicant to be drawn to non-elected species.

In response, newly amended claim 1 based on the combination of claims 1, 12 and 22 is uncontested as being within the “elected species”.

However, regarding claims 20 and 21, Applicants point out that the election of species requirement was made based on figures, not claims. The elected figure was Fig. 1. Applicants had requested correction of the designation of claims. Any question as to whether certain claims do or do not read on figures must be resolved by reference to the figures. Since claims 20 and 21 clearly claim features shown in Fig. 1, these claims should have been included in the claims indicated to read on Fig. 1. The Examiner does not explain his position as to difference of species, and his position is not understood.

Further, the Examiner indicates that “applicant has already received examination based on limitations of figure 1”.

Since Applicant has received examination based on limitations of figure 1, then Applicant has received examination of claims 20 and 21 - as well as claims 12 and 22. Thus, there would be no harm to correcting the designation of claims 20 and 21 as repeatedly requested by Applicants.

The Examiner indicates that “Since applicant has received examination based on limitations of figure 1 ...”.

In response, Applicants point out that Applicant has

- originally designated claims 12 and 22 (“sequential wave peaks exhibit decreasing radial height”) as being in the elected species of Fig. 1
- received examination of claims 12 and 22
- currently amends all base claims to include the limitations of claims 12 and 22

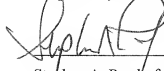
thus, according to the Examiner’s own standards, the current Amendment is limited to subject matter previously designated as corresponding to the invention of Fig. 1, and previously examined, thus can not be withdrawn as belonging to non-elected species.

Accordingly, it is respectfully requested that the Notice of Noncompliant Amendment be withdrawn, and that the present claims be entered together with the arguments filed in the Amendment filed May 28, 2009.

The remainder of the Amendment filed May 28, 2009 remains unchanged.

The Commissioner is hereby authorized to charge any fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account Number 16-0877.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Stephan A. Pendorf', is written over a horizontal line.

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